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IN THE

Supreme Court of the United States

INFINEON TECHNOLOGIES AG,
INFINEON TECHNOLOGIES NORTH AMERICA CORP., AND
INFINEON TECHNOLOGIES HOLDING NORTH AMERICA INC.,
Petitioners,

v.

RAMBUS, INC.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether petitioner failed to prove its state-law fraud claim by the required clear and convincing evidence.

2. Whether the court of appeals correctly construed a patent claim term in accordance with its plain ordinary meaning, where the patent specification did not override that meaning and the prosecution history affirmatively supported it.

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RESPONDENT'S BRIEF IN OPPOSITION

Infineon's petition presents only case-specific issues not warranting further review. The primary issue merely challenges a record-dependent determination of evidentiary insufficiency on a state-law fraud cause of action. The secondary issue at bottom merely challenges a (unanimous) construction of one particular patent claim term. In both respects the ruling below is correct and raises no general legal issue, let alone one that merits certiorari review.[1]

STATEMENT

A. Background. In 1990, inventors Mike Farmwald and Mark Horowitz filed a wide-ranging patent application describing a wealth of inventions for speeding up the transfer of data in and out of computer memory. They founded Rambus to commercialize their inventions through licensing and technological assistance to manufacturers like Infineon. The counterpart European patent application, in all material respects the same as the 1990 U.S. application, was published by late 1991 and known to Infineon by May 1992. Pet. App. 28a, 31a, 153a; Ct. App. JA ["CAJA"] 18268.

The United States Patent and Trademark Office (PTO) quickly recognized that the 1990 U.S. application contained many "independent and distinct inventions" (35 U.S.C. § 121). It therefore required Rambus to pursue those inventions through numerous separate applications—just as an application describing a car made extremely fast by a host of independent inventions would have to be divided into distinct applications separately claiming those which operate independently of one another. *See* Pet. App. 21a-22a. For Rambus, the extensive process of refining and prosecuting the

[1] No other publicly held company owns 10% or more of the stock of respondent Rambus. *See* Sup. Ct. R. 29.6.

separate applications continued through the 1990s. All the patents and applications at issue in this case share the original written description, which, in 1990, described all the inventions later claimed.[2] So fertile was the 1990 application that dozens of patents have now issued to Rambus from that application. *Id.* at 2a.

In December 1991, Rambus, a new company invited by industry leaders, attended its first meeting of the Joint Electron Devices Engineering Council (JEDEC), which was part of the Electronic Industries Association (EIA). JEDEC was a forum in which the major competitors in the semiconductor industry engaged in standard setting. It had regular meetings—open to anyone paying dues, with the minutes and proposed standards publicly available (Pet. App. 34a; CAJA1558, 3394-98)—to develop common specifications for certain technologies so that different manufacturers could make interchangeable parts.

There are numerous standard-setting organizations nationally and worldwide. Such organizations recognize the relevance of intellectual property to technological standards. (Pet. App. 31a). They also recognize **(a)** the legitimate interest of firms in maintaining secrecy of ever-changing, often-rejected patent-development efforts until they have been made final through actual issuance of a patent (35 U.S.C. § 122 (1994 ed.)), which minimizes pre-issuance priority contests (35 U.S.C. § 135) and jeopardy to foreign patent rights (Pet. App. 34a n.9), *see* Infineon CA Br. 21 ("Rambus'

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[2] To be entitled to the 1990 priority date, later applications introducing new *claims* shared the original 1990 written description, which had to support the new claims. 35 U.S.C. §§ 120, 121 (continuation and divisional applications). The filing of such applications has long been the standard procedure enabling inventors to secure protection in properly drafted claims for all inventions described in an original application. *See Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.*, 285 F.3d 1046, 1055 (Fed. Cir. 2002) (*en banc*); *In re Hitchings*, 342 F.2d 80, 85 (CCPA 1965).

pending patents were of course confidential"); **(b)** the antitrust delicacy of competitors sharing information about their in-process innovations where innovation is a central aspect of rivalry (Pet. App. 23a n.7; *Allied Tube & Conduit Corp. v. Indian Head, Inc.*, 486 U.S. 492, 501, 506-07 (1988)); and **(c)** the interest in ensuring that firms with relevant knowledge are not deterred, by onerous or unclear membership duties, from participating in what can be important public forums (Pet. App. 35a n.10). They balance such considerations in a variety of ways to adopt widely varying duties of disclosure and licensing for members' developed or nascent intellectual property.[3] Notably, the patent policy of the umbrella organization, the American National Standards Institute, does not require disclosure of mere patent applications, limiting disclosure duties to certain *issued* patents.[4] In the present case, the particular disclosure duty for members of JEDEC, as part of EIA, became a central issue.

Rambus was a member of JEDEC for calendar years 1992 through 1995. It attended its last meeting in December 1995 and confirmed its withdrawal by letter in June 1996. In 1993, the relevant JEDEC committee adopted a standard for

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[3] An *amicus* brief submitted by GlobalPlatform *et al.* in the Federal Circuit noted (at 9) that "circumstances vary widely in standard setting" and there is no "'one size fits all' approach" to standard-setting organizations' disclosure policies. *See also* Lemley, *Intellectual Property Rights and Standard Setting Organizations*, 60 Calif. L. Rev. 1889 (2002). Elsewhere, counsel for those *amici*, while mischaracterizing aspects of the evidence, wrote that the Federal Circuit decision in this case, in "following the letter of the law," was no "surprise." www.consortiuminfo.org/bulletins (Feb. 2003).

[4] *See* Testimony of Amy Marasco, at www.ftc.gov/opp/intellect-/020418marasco.pdf (ANSI general counsel explaining that ANSI's "Patent Policy does not apply to pending patent applications"). A recent survey indicates that very few standard-setting organizations require disclosure of unpublished patent applications, and even fewer require such disclosure from passive members, like Rambus, who never propose standards. Lemley, 60 Calif. L. Rev. at 1904-05.

synchronous dynamic random access memory (SDRAM); by then, "all JEDEC members had notice of the written description of all of Rambus's patents." *Id.* at 31a. After Rambus left JEDEC, the committee first proposed and later adopted a standard for a double-data rate form of such memory—DDR SDRAM. Not until 1998, two years after leaving JEDEC, was Rambus able to draft and file in the PTO the patent applications that, upon issuance in 1999 and 2000, it asserted against products built to the SDRAM or DDR SDRAM standards.

B. District Court Proceedings. In 2000, Rambus sued Infineon for infringement of several newly issued patents. Infineon counterclaimed, alleging that Rambus committed fraud under Virginia law by failing to disclose, while it was at JEDEC, certain *earlier* patent claims that Rambus had on file in the PTO at that time. Because the full written description of all patents and applications at issue had in fact been disclosed, the only alleged nondisclosure could be of *claims* that Rambus had filed in the PTO before leaving JEDEC. Infineon's fraud theory relied on such pre-1997 claims, even though most never issued and none has ever been asserted against Infineon (or other JEDEC-compliant SDRAM or DDR SDRAM makers).

1. Patent Infringement. During trial, the district court granted Infineon judgment of noninfringement, based on a severely scope-narrowing construction of the claim term "bus." That term appears alone, without modification by the phrases that *in other claims* require a special kind of bus, in certain claims to the *other* speed-enhancing inventions for use with any "bus." But the district court ruled that *all* of Rambus's claims required a special kind of "multiplexing" bus—in which each of the lines that carry data also carry address and control information. *Id.* at 100a.

Such multiplexing plainly is not part of the term's well-known ordinary meaning: Infineon itself told the jury that "it

just says 'bus,' but it doesn't mean bus ***." CAJA2001. Indeed, the district court *accepted* that "bus" had an ordinary meaning not requiring multiplexing (and that dictionaries could properly help identify such ordinary meaning). Pet. App. 80a-81a & n.8. Nevertheless, the court held that, even without modifiers, the term "'bus' actually has a specialized meaning conferred by the specification of the patents in suit," so that even claims to Rambus's other independent inventions must require the multiplexing bus shown in the specification describing embodiments combining such inventions.[5] *Id.* at 81a, 80a-100a. On that basis, the court removed Rambus's infringement case from the jury. *Id.* at 5a.

2. State-Law Fraud. Infineon's counterclaim of nondisclosure-based fraud went to the jury. Infineon had the burden of proving all the required elements by clear and convincing evidence. The threshold issue was precisely what information a JEDEC member had a duty to disclose and whether Rambus had something undisclosed within that duty. Only if Infineon and other members actually and justifiably expected a particular fact to be disclosed could silence about it constitute a false representation of its nonexistence. Because the common written description was known, *claims* were the only possible subject of nondisclosure. *Id.* at 28a-29a, 31a.[6]

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[5] The description of a particular embodiment that includes multiple inventions in particular forms responds to the basic statutory requirement that the written description show "the *best mode* contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112, ¶ 1 (emphasis added).

[6] Under Virginia law, which requires a full inquiry when there is reason to make inquiry, Infineon also had to prove that it reasonably relied on the asserted nondisclosure of some patent claims from between 1991 and 1996—despite Infineon's and JEDEC's having the full 1990 written description for all the post-1990 claims, knowing that Rambus sought additional patents (CAJA16524), openly worrying about what patents Rambus was seeking based on the 1990 application (CAJA1650-51, 6534, 9054), concededly relying on others' assurances that any broad claims

Infineon's position always has been that what required disclosure was *some subset* of the class of "pending and issued patents" held by Rambus during its JEDEC membership, nothing more. Infineon CA Br. 14; Pet. App. 135a (JMOL ruling); CAJA11717 (jury instruction). It was undisputed that no disclosure duty attached *either* to applications filed in the PTO after a member left JEDEC *or* to a current member's *intention* to file applications in the PTO. Pet. App. 34a.[7] The latter indisputable limitation is critical because, even in this Court, Infineon presents as its central grievance the nondisclosure of *plans* to file claims broad enough to capture Rambus inventions being incorporated into the JEDEC standards. *See* Pet. 6, 19. The sole question at trial was which claims within the class of current members' *on-file* applications and issued patents had to be disclosed at JEDEC.[8] More specifically, the question was what disclosure

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could be invalidated (Infineon CA Br. 7-8; CAJA2775-76), and being told explicitly by Rambus not to rely on its silence (CAJA9115 ("[o]ur presence or silence at committee meetings does not *** make any statement regarding potential infringement of Rambus intellectual property")), yet never directly asking Rambus to state what patent protection it planned to seek. The sufficiency of Infineon's proof in this regard was an issue not reached by the court of appeals.

[7] Regarding *plans*, Infineon's JEDEC representative Meyer testified (CAJA4637-38): "Q: *** Did JEDEC patent policy require members to disclose plans to file patents in the future? *** A. No. *** Q: Do you recall testifying *** that JEDEC's patent policy did not require its members to disclose any plans they had to modify applications in the future? A: That's what I said. It was never mentioned in any of the discussions. Q: *** [I]t was your understanding that that was not required; is that right? A. Yes." *See* CAJA19099 (JEDEC official McGhee) (same); Pet. App. 34a.

[8] JEDEC members included IBM, Toshiba, Samsung, Hewlett-Packard, and other companies collectively receiving thousands of patents every year. A large number of such patents relate in some general sense to the DRAM memories with which JEDEC was concerned. Pet. App. 32a-33a; CAJA1580 (committee chairman: IBM itself had "hundreds, if

duty Infineon proved by clear and convincing evidence, *i.e.*, what relation particular claims had to have to what particular activity at JEDEC for the filing of such claims to trigger the disclosure duty.[9]

The evidence, as recounted by the court of appeals (Pet. App. 24a-35a), included JEDEC's written policies on disclosure and, among other things, the testimony of Infineon's own JEDEC representative, Meyer, as to his understanding (which necessarily limited *Infineon*'s disclosure expectations). Explaining his own nondisclosure of an Infineon patent application "related" in some sense to SDRAMs, Meyer made clear the outer limits of the disclosure-triggering relation, tying it naturally to the reason JEDEC wanted certain patent-related information in the first place: a pending or issued claim had to be related to a particular proposed standard *in the sense* that practicing the standard would support an assertion of infringement and hence a license demand. *Id.* at 30a.[10] Only claims with that relation had to be disclosed. As to whether Rambus, while at JEDEC, had any pending or issued claims having *that* relation to standards under

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not thousands," of patents related to DRAMs), 4643 (Infineon's Meyer: "lots" of patents related to SDRAMs).

[9] There was a serious question whether passive members (those not proposing standards) had to disclose mere patent applications, rather than issued patents. Because that distinction was not the basis of the court of appeals' ruling in this case, it is here assumed *arguendo* that the duty encompassed patent applications.

[10] "Q: What was your understanding of the relationship that a patent had to have in order to be disclosed under JEDEC's patent policy? A: Well, it had to be *related to the work at JEDEC in the sense that it described features that were necessary to meet the standard.* Q: In other words, in order to practice a standard, it would be necessary to use the feature that was patented, right? A: Yes. Q: So *if the patent would not be required to be used in order to practice the standard, it didn't have to be disclosed, right?* A: If it was—as I said, if it was a circuit, which could be done differently, then *no*." CAJA4643-44; Pet. App. 30a (emphases added).

consideration at JEDEC, Infineon never contended that Rambus did, and twice Infineon asserted that Rambus did not. CAJA4798-99, 13195-; *see* Pet. App. 38a.

In the face of such evidence, Infineon argued its case to the jury at a high level of generality, relying on a broad-brush assertion of a duty to disclose certain claims "related" in an unspecified sense to standards JEDEC was discussing. The jury was persuaded: it found for Infineon on separate questions for the SDRAM standard and the DDR SDRAM standard. The district court granted Rambus judgment as a matter of law as to the DDR SDRAM standard, but allowed the verdict as to the SDRAM standard to stand, relying (like Infineon) on an undefined "related to" duty. Id. at 134a-135a, 143a-146a.[11]

C. Court of Appeals Decision. 1. Claim Construction. The Federal Circuit unanimously reversed the district court's claim construction in three respects and therefore remanded with Rambus's infringement count reinstated. *Id.* at 8a-22a. The court recited the accepted principles that "a claim term means 'what one of ordinary skill in the art at the time of the invention would have understood the term to mean,'" *id.* at 9a (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996)), unless the inventors have "use[d] the specification [or prosecution history] to supply implicitly or explicitly new meanings for claim terms." *Id.* The court also noted the basic principle that, "[w]hile claims often receive their interpretative context from the specification and the prosecution

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[11] The district court concluded that Infineon had failed to prove that a disclosure duty was triggered as to the DDR SDRAM standard, because that standard was not even proposed at JEDEC until after Rambus left. Pet. App. 166a-169a. The court of appeals, without dissent, affirmed that grant of judgment as a matter of law (*id.* at 33a, 40a), which is not the subject of Infineon's certiorari petition and is not otherwise addressed here.

history, courts may not read limitations into the claims." *Id.* at 9a-10a (citing, *e.g.*, *Markman*, *supra*). The court then proceeded to apply those principles to three disputed claim terms.

Regarding "bus," the claim term now at issue, the court of appeals noted that the district court had not disputed the ordinary meaning of the term but, rather, had concluded "that the patentees had acted as their own lexicographer by redefining 'bus' to be a multiplexed bus"—one whose "'signal lines [are] used to transmit address, data and control information.'" *Id.* at 19a. Reviewing that conclusion, the court of appeals first noted what was not disputed by the district court:

> The term "bus" is very common in the electrical arts and has a well-recognized meaning in such arts, namely, a set of signal lines (e.g., copper traces on a circuit board) to which a number of devices are connected, and over which information is transferred between devices.

Id. (citing *The New IEEE Standard Dictionary of Electrical and Electronic Terms* 141 (5th ed. 1993)). As the district court had accepted, that ordinary meaning requires no multiplexing. *Id.* The court of appeals then noted that "[n]othing in the claims" compels a different construction but that "[b]efore according 'bus' this meaning, *** [it] must consider the usage and meaning of the term as used in the relevant context of the specification." *Id.*

The court observed that most references to "bus" in the specification do not even arguably suggest a limitation of the ordinary meaning to a multiplexing bus. *Id.* It then noted two statements about "the present invention" that might suggest such a limitation (*id.* at 19a-20a), but it concluded that, considered in context, they do not. *Id.* at 20a-21a. In particular, "the prosecution history shows that a multiplexing bus is only one of many inventions disclosed in the [original 1990] application." *Id.* at 21a. "Although some of Rambus's

claimed inventions require a multiplexing bus, multiplexing is not a requirement of all of Rambus's claims." *Id.* The original application's claims pointedly *added* modifiers to "bus" when claiming the "inventive multiplexing bus," confirming that "bus" without such modifiers was not already limited to multiplexing in the specification. *Id.* And the PTO's requirement that Rambus divide its multiple inventions into separate applications, some requiring multiplexing and others not, "demonstrated an understanding of 'bus' that is not limited to a multiplexing bus." *Id.* at 21a-22a.

2. State-Law Fraud. The court of appeals also reversed the district court's denial of judgment as a matter of law respecting the SDRAM standard. *Id.* at 22a-39a. "Infineon bore the burden of proving the existence of a disclosure duty and a breach of that duty by clear and convincing evidence." *Id.* at 39a. The court concluded that "[n]o reasonable jury could find" that Infineon had carried its burden. *Id.*

The court first reviewed what Infineon proved the EIA/JEDEC disclosure duty to require. *Id.* at 24a-35a. Infineon, before the court of appeals, relied *entirely* on a simple and unelaborated assertion that the JEDEC duty was to disclose claims "'relating to' JEDEC standardization" (Infineon CA Br. 21-22)—as it does in this Court, too (Pet. 5, 12). The court of appeals, however, examined *what* "relation" Infineon proved a patent claim had to have to standards to trigger disclosure.[12] The court observed that the governing EIA/JEDEC policy—the only such language ever shown to members—"identifies the duty to disclose based on the scope of claimed inventions that would cover any standard and cause those who use the standard to infringe." Pet. App. 28a. The court then recounted the description of the policy by the

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[12] This Court has noted the "indeterminacy" of a "relates to" standard without more concrete definition. *New York Conference of Blue Cross v. Travelers Ins. Co.*, 514 U.S. 645, 655-56 (1995) ("unhelpful text").

relevant committee chairman, Kelley, as requiring a patent's disclosure when "'*design or production of the component that was being standardized would require the use of that patent*'" (*id.* at 29a). *See id.* at 30a ("'the JEDEC policy *** of notifying the committee when there are patents issued that *** *read on or apply directly to* the activities of a standards process'"). The court also recited the critical understanding of Infineon's own JEDEC representative Meyer (*see* note 10, *supra*) that, for a patent claim to be within the disclosure duty, "'*it had to be related to the work at JEDEC in the sense that it described features that were necessary to meet the standard.*'" *Id.*

In accordance with "the primary JEDEC goal of adopting open standards that can be practiced without unreasonable license fees or terms," the court concluded that Infineon's own witnesses, together with the documentary evidence, "indicate that the relevant disclosure duty hinges on whether the issued or pending claims are needed to practice the standard." *Id.* at 31a (footnote omitted). Only "claims in patents or applications that reasonably might be necessary to practice the standard"—"claims that a competitor or other JEDEC member reasonably would construe to cover the standardized technology"—had to be disclosed. *Id.* at 31a-32a. Infineon's proposed "amorphous duty" based on a claim's "having a vague relationship to the standard" was further undermined by its own nondisclosure of an SDRAM-related patent (because, as Meyer said, its use was not required) and by the tiny number of patents and applications actually disclosed by the industry giants participating in JEDEC. *Id.* at 32a-33a. The court noted that plans to file patent applications did *not* require disclosure (*id.* at 34a), and it took care to note that JEDEC "*could* have drafted a policy broad enough to capture a member's failed attempts to mine a disclosed specification for broader undisclosed claims. It could have. It simply did not." *Id.* at 35a (emphasis added).

The remaining question was whether Infineon proved that Rambus failed to disclose any claims, pending or issued while it was at JEDEC, that came within the disclosure duty–claims that would reasonably support an infringement claim (and thus support a license demand). Infineon never argued to the panel that Rambus had any such claims, even when specifically asked at oral argument and even though Rambus had, in its opening brief's opening argument, discussed each of the pending applications the district court had identified as improperly kept undisclosed (*id.* at 143a-144a). *See id.* at 38a (despite Rambus's "repeated assertions *** that these claims were not necessary to practice the SDRAM standard, Infineon does not directly address Rambus's arguments"). Nevertheless, the court of appeals, doing Infineon's work for it, reviewed those applications and concluded that none could be reasonably read to be required by the SDRAM standard. *Id.* at 35a-38a. Accordingly, "Infineon did not show the first element of a Virginia fraud action and therefore did not prove fraud associated with the SDRAM standard." *Id.* at 39a.[13]

Judge Prost dissented on the record-specific ground that, in her view, Infineon had presented sufficient evidence of a breached duty of disclosure regarding the SDRAM standard. *Id.* at 44a-66a. She did not dissent with respect to either the claim construction or the DDR SDRAM judgment as a matter of law. Infineon sought panel and en banc rehearing, with support from four *amicus* briefs, but the requests were denied with no record of dissent. *Id.* at 68a.

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[13] Although Infineon criticizes the court of appeals for asking the parties for "documents that were not in the *appellate appendix*" (Pet. 9 (emphasis added); *id.* at 2, 17, 18), it cannot and does not say that the court requested, received, or relied on material outside the district court record. Securing record material not included in the appendix is routine. *See* Fed. R. App. P. 30(a)(2) ("Parts of the record may be relied on by the court or the parties even though not included in the appendix."); Sup. Ct. R. 26.2.

ARGUMENT

Neither of Infineon's two challenges to the court of appeals' decision warrants review by this Court. The decision involves no significant legal rulings, let alone federal-law rulings on which a conflict of the circuits has been or could be suggested. The court of appeals applied undisputed legal standards for reviewing evidentiary sufficiency on a state-law claim and followed established principles in construing a patent claim term. Its decision on both the state-law issue and the patent issue is a wholly fact-specific application of settled legal standards. Most of Infineon's petition, indeed, does not even purport to present legal issues, but only a high-pitched disagreement with the result in the particular case. Such a disagreement, even when accompanied by a baseless assault on the Federal Circuit's overall fidelity to law, does not warrant review. In any event, Infineon is wrong, and the court below was correct, on the intensely record-specific evidentiary and claim-construction matters it decided. The petition should therefore be denied.

I. CERTIORARI SHOULD BE DENIED ON THE STATE-LAW FRAUD ISSUE

Attempting to get around this Court's consistent practice of not reviewing state-law matters (*Wharf (Holdings) Ltd. v. United Int'l Holdings, Inc.*, 532 U.S. 588, 596 (2001)), Infineon attacks the court of appeals' sufficiency-of-the-evidence ruling. Review for sufficiency is authorized by Fed. R. Civ. P. 50 and the Seventh Amendment and goes on daily in federal trial and appellate courts.[14] Indeed, such review is "necessary for the vigorous functioning of the jury system"

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[14] *See, e.g., Weisgram v. Marley Co.*, 528 U.S. 440, 450-52 (2000); *Gasperini v. Center for Humanities, Inc.*, 518 U.S. 415, 436 n.20 (1996); *Neely v. Martin K. Eby Constr. Co.*, 386 U.S. 317, 321, 324, 327-28 (1967); *Galloway v. United States*, 319 U.S. 372, 389 (1943); *Boyle v. United Technologies Corp.*, 487 U.S. 500, 514 (1988).

and "essential to the preservation and proper application of the applicable substantive law."[15] Whether the evidence is insufficient in a particular case necessarily depends on the record in that case–*all* the evidence. *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150-51 (2000). Evidentiary sufficiency on a state-law question, if ever certworthy, certainly is not in this case. Indeed, the court of appeals' ruling was correct.

A. Duty. Infineon's first argument does not even purport to be a legal one. It does not question the court of appeals' "reasonable jury" standard requiring that the actual evidence reasonably meet the burden of proof (here, clear and convincing evidence) on each element of the claim. (Indeed, Infineon does not question the rulings of the district court and a unanimous court of appeals finding insufficient evidence as to the DDR SDRAM standard.) Rather, Infineon simply challenges the judgment that the particular evidence in this case failed to establish a breached disclosure duty as the first essential element of fraud under Virginia law. Pet. 11-16. That challenge is not certworthy, and the bits of evidence recited by Infineon in no way undermine the court's conclusion as to the maximum disclosure duty supportable in the record: the "relation" required for an on-file claim to trigger disclosure was that it must be reasonably read to cover a JEDEC standard and hence support a license demand.

Thus, the passing statement by JEDEC official John Kelly (who had never attended a meeting of the JEDEC committee at issue and who was not purporting to offer an interpretation of the disclosure duty) itself speaks of claims "that are or may

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[15] 9A C. Wright & A. Miller, *Federal Practice and Procedure* § 2522, at 244-246 (2d ed.1995) (internal quotation marks omitted), cited in *Gasperini*, 518 U.S. at 436 n.20; *see Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 n.8 (1997) (importance in patent cases); *Brooke Group Ltd. v. Brown & Williamson Tobacco Corp.*, 509 U.S. 209 (1993).

be *required* to comply with the standard." CAJA3360. Gordon Kelley, the committee chairman, even in the Infineon-quoted excerpt spoke of claims that "cover" JEDEC standard proposals (Pet. App. 53a; CAJA15975) and elsewhere confirmed that what triggered disclosure was that "the design or production of the component that was being standardized would *require* the use of that patent" (Pet. App. 29a; CAJA19057; *see also id.* 19055). Infineon quotes the district court's summary of JEDEC consultant Reese Brown's testimony (Pet. App. 141a-142a), which used "relating to" as a shorthand in focusing on other issues and, when indicating *what* the required relation was, spoke of members having a "patent position or potential patent positions *on the material*" in a standard proposal. CAJA19031, 19032. Infineon's own JEDEC representative Meyer, while similarly using the shorthand "in relationship to" (Pet. App. 53a-54a; CAJA2745), made crystal clear *what* the relationship had to be–as quoted at Pet. App. 30a and note 10, *supra*. (All emphases above added.)

When Infineon turns to the actual EIA/JEDEC patent policy from EIA/JEDEC documents, it simply ignores the only policy that was ever shown to members–the EIA policies shown as slides at every meeting Rambus attended. *See* Pet. App. 25a-27a. *That* language, as Infineon does not even bother to deny, "links the disclosure duty to patents or applications whose claims cover the proposed JEDEC standard." *Id.* at 27a-28a. Instead, Infineon quotes a directive to committee chairpersons that (a) was not shown to members as the disclosure duty and (b) was not by its terms "a statement of the duty, but *** a requirement [for] the chairperson to point members to the duty in" the above-referenced policy that *was* shown to members (the one Infineon ignores). *Id.* at 27a. And the ballot language, aside from being limited to "patents" (not applications), speaks of "'patents involving this ballot'" (*id.* at 52a) without changing the understanding of

how the patent had to involve the balloted standard, as indicated in the policy actually shown to members.

Infineon criticizes the court of appeals for noting the "amorphous" and "unbounded" nature of the wholly undefined "related to" duty that Infineon attributed to JEDEC. Pet. 14. But that fact *is* relevant to evidentiary insufficiency: it renders Infineon's proffered duty "implausible" on the record showing so few patents or applications disclosed at JEDEC—a record that Infineon has to explain away as showing that industry giants in JEDEC pervasively violated the supposed disclosure duty. *Id.* In contrast, the underlying concern with whether license demands will be made against products built in conformity with an adopted standard fits the duty to disclose as shown by the evidence as summarized by the court of appeals. Pet. App. 31a. Contrary to Infineon (Pet. 15-16), standardized products are built under adopted, not rejected, standard proposals; and license demands require, at a minimum, patent claims that reasonably read on adopted standards. That inquiry, while not perfect in predictability, is the one familiar to technical people dealing daily with technical specifications and technical patents. Indeed, patent claims "must be understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology." *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).[16]

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[16] Infineon says that the disclosure-duty issue was not properly raised by Rambus below. Pet. 15 n.4. That contention is not part of the question presented and is wrong, as shown by the Federal Circuit's unanimous treatment of the argument on the merits. Rambus's very first argument on fraud was that the disclosure duty, whatever it might affirmatively encompass, reached no further than filed or issued claims supporting a license demand, of which Rambus had none while at JEDEC. Rambus CA Br. 26-29. Infineon recognized and addressed the argument, asserting a broader duty. Infineon CA Br. 16-18, 21-22. This was again Rambus's primary argument in its reply brief (at 1-8 & 30 n.17) and at oral

B. Breach. Turning from what the duty was to whether Rambus breached it, Infineon's primary point about the court of appeals' insufficiency holding is framed as a legal argument. It suggests that a remand was required for the district court to consider whether Infineon should receive a new trial. Pet. 16-18. This argument is incorrect.

The very decisions Infineon cites make explicit that, under 28 U.S.C. § 2106 and Fed. R. Civ. P. 50(d), an appeals court, upon finding evidentiary insufficiency, acts properly in ordering judgment as a matter of law without such a remand, where, as here, the verdict winner had an unimpeded opportunity to present its evidence. *See Weisgram*, 528 U.S. at 449-452 (affirming appellate JMOL); *Neely*, 386 U.S. at 321, 324, 327-28 (affirming appellate JMOL); *see also*; *New York, N.H. & H. R. Co. v. Henagan*, 364 U.S. 441 (1960); *Herdman v. Pennsylvania R. Co.*, 352 U.S. 518 (1957). In such circumstances, bringing the claim to an end ensures fairness to *both* sides and serves the essential Rule 50 policy "to speed litigation and to avoid unnecessary retrials" (*Neely*, 386 U.S. at 326). A remand may be necessary where, for example, the jury failed to rule on the plaintiff's expressly presented alternative grounds of liability (so that insufficiency of evidence on the limited grounds addressed by the jury cannot end the case), *Iacurci v. Lummus Co.*, 387 U.S. 86 (1967), or where the evidentiary insuffic-iency may be due to exclusion rulings or other actions of the trial court (*Neely*, 386 U.S. at 327). *See Weisgram*, 528 U.S. at 451 n.7, 456 n.13. Even then, such specific grounds warranting a remand for consideration of a new trial must be raised before the appeals court. *Neely*, 386 U.S. at 327-28; *see* Fed. R. Civ. P. 50(d). But no such circumstances are remotely present, or were identified to the court of appeals, here: the jury fully addressed Infineon's contentions and Infineon incurred no

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argument, as to both the SDRAM and DDR SDRAM issues. Infineon said nothing about waiver until its rehearing petition below.

impediment to full presentation of its case at trial. Infineon is simply demanding a second bite at the apple after failing to prove its case, which basic principles of fairness, efficiency, and finality preclude. *See, e.g., Boyle*, 487 U.S. at 513-14; *Burson v. Carmichael*, 731 F.2d 849, 854 (Fed. Cir. 1984).

Infineon's secondary argument criticizes the court of appeals for "scouring the record to determine whether" Infineon proved a breach of the maximum disclosure duty the record would support. Pet. 18. Infineon offers no legal citation for this criticism, which is badly misplaced. The court could have simply held Infineon to its admission, by its silence on appeal, that Rambus had no undisclosed claims supporting a license demand. In responding to Rambus's plain contention that it had no undisclosed pending claims assertable against practice of a proposed standard at JEDEC (Rambus CA Br. 27-28, discussing specific pending claims based on district court's citations), Infineon, before the panel (in its briefs and at oral argument), never even denied Rambus's contention, much less identified a single pending claim purporting to disprove it. It chose instead to rely *solely* on arguing for a broader disclosure duty. Appellees have a duty to raise their arguments and identify supportive parts of the record in their brief, not save arguments for rehearing or foist on appeals courts the task of combing the record for themselves.[17] The Federal Circuit, in examining the sole pending Rambus claims that had even arguably been placed in issue, thus gave Infineon fuller consideration of the merits than it deserved.

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[17] *See* Fed. R. App. P. 28(a)(9)(A), (b); *Pentax Corp. v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998); *FDIC v. Massingill*, 30 F.3d 601, 605 (5th Cir. 1994); *Costo v. United States*, 922 F.2d 302, 302-03 (6th Cir. 1990); *Morrison Knudsen Corp. v. Fireman's Fund Ins. Co.*, 175 F.3d 1221, 1239 n.18 (10th Cir. 1999); *Johnson v. City of Ft. Lauderdale*, 126 F.3d 1372, 1373 (11th Cir. 1997).

On the merits, Infineon rehearses an evidentiary-sufficiency contention (Pet. 18-20) that is wholly case-specific and, in any event, meritless. Dispositively, Infineon does not now identify even a single undisclosed patent claim that Rambus had pending while at JEDEC that could reasonably support infringement (and hence a license demand). In the district court, Infineon submitted a "Statement Identifying Specific Pending Rambus Patent Applications that Related to JEDEC's SDRAM and DDR SDRAM Standardization Work" (July 6, 2001), from which the district court's discussion on JMOL evidently was drawn (Pet. App. 143a-144a). But that submission spoke only of claims "related to" JEDEC standardization, and Infineon twice told the district court that Rambus did *not* get broad enough claims filed until at least 1998. *See* p. 8, *supra*. Before the appellate panel, Infineon again relied entirely on its assertion of a broader "related to" duty, without identifying any undisclosed pre-1998 Rambus claim that could reasonably be read to cover a JEDEC standard. In its rehearing petition, Infineon finally pointed to *one* Rambus application, but Rambus, in its response, showed that the contention was incorrect and waived (*e.g.*, this application was not even listed in Infineon's above-cited district court submission). Infineon has now abandoned all pretense of being able to identify such a claim.

Where the universe of on-file patent claims was sitting in the record and available for direct examination, anything less than identification and direct discussion of individual claims could not suffice to establish whether, objectively, they could reasonably be read to cover relevant JEDEC standards. The inquiry, like an infringement inquiry, must involve element-by-element comparison of individual claim terms to the particular JEDEC standards. *See Warner-Jenkinson*, 520 U.S. at 29. Infineon cannot here make up for its utter failure to do so by now pointing to **(a)** certain company officials' unconfirmed, soon-corrected, *assumptions* about claims they had not even directly read and compared to standards (*e.g.*, a

1992 Rambus business plan, Pet. App. 60a; CAJA16382, or an email stating "I believe" Rambus had certain claim but noting "we need to check," Pet. App. 61a; CAJA16050, 16054), or **(b)** testimony about *plans* to add certain claims (Pet. App. 62a, 145a, quoting a mere question by Infineon's counsel, answered *negatively*, "I'm not sure that I did that" and "I didn't know what we had claimed or what we hadn't claimed," 5/2/01 Trial Tr. 133-34), or **(c)** testimony about having claims on undefined "aspects" of certain technologies, which does not even begin to suggest coverage of specific JEDEC versions (Pet. App. 63a; CAJA13202-04). The court of appeals here correctly found such evidence insufficient, given that subjective beliefs about patent coverage are "largely irrelevant" to their objective scope,[18] that Infineon conceded the absence of Rambus claims broad enough to cover the standards, and that Infineon failed to identify a single undisclosed pending Rambus claim that could reasonably be read as covering the standards.

C. Narrowness. The court of appeals thus correctly held that Infineon failed to prove *either* the broader duty on which it relied *or* the existence of filed Rambus claims within the maximum pre-1996 JEDEC duty Infineon proved. The court of appeals' decision, even in its state-law aspects, is no broader than that. It does not reach other standard-setting organizations, or even any post-1996 policies of JEDEC itself, and it *expressly* does not limit any standard-setting organization's ability to define its disclosure policies. Pet. App. 35a ("JEDEC could have drafted a patent policy with a broader disclosure duty. *** It simply did not."). The decision is thus narrow as well as correct, and it presents no issue warranting certiorari review.

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[18] *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379 (Fed. Cir. 2000); *see Markman*, 52 F.3d at 985-86.

II. CERTIORARI SHOULD BE DENIED ON THE CLAIM CONSTRUCTION ISSUE

Infineon's second question tries to make a general legal issue out the court of appeals' unanimous construction of the claim term "bus." Pet. 20-29. But the court of appeals followed a perfectly correct methodology, over which there is no dissension in the Federal Circuit or in other circuits.[19] It started with the ordinary meaning of the claim term, which was not disputed even by the district court (and was effectively conceded by Infineon), then analyzed the specification and prosecution history to determine whether the inventors had adopted a different meaning. The court found that the specification did not alter the ordinary meaning and that the alteration urged by Infineon was positively incompatible with the prosecution history. This claim construction (returning the case, currently in an interlocutory posture, to proceed on infringement) is correct and presents no issue for review.

In trying to make a general legal issue out of this familiar course of claim construction, Infineon's entire presentation rests on a conflation of two distinct issues. One is whether the ordinary meaning of a claim term (to a person skilled in the relevant art) presumptively governs its proper construction, subject to a different meaning being established, for example, in the specification or prosecution history. The second is whether, in ascertaining the ordinary meaning, the court may look to relevant dictionary definitions if needed. With those questions separated, it is clear that there is no

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[19]Infineon asserts that "there can be no circuit split" on patent issues (Pet. 2), but that is not so. *See Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc.*, 535 U.S. 826 (2002) (case involving patent counterclaim appealable only to regional circuit); *Telecomm Technical Servs. v. Siemens Rolm Communications, Inc.*, 295 F.3d 1249 (Fed. Cir. 2002) (transferring to regional circuit appeal in case involving patent infringement counterclaim).

issue in need of any review, least of all in this case, where an unimpeachable approach to claim construction was applied.

A. Dictionaries. Infineon seems to rely principally on a criticism of the use of dictionaries, but that criticism is a red herring in this case. The ordinary meaning of the very common term "bus" in the relevant field is not in dispute. The district court accepted that the ordinary meaning did *not* require multiplexing; the unanimous court of appeals made the same point; Infineon admitted as much when it stated its position that the term "bus" in these patents "does not mean 'bus'"; and *no* dictionary definition was introduced that included a multiplexing element, the only point in dispute. The court of appeals' reference to a dictionary, thus, was mere confirmation of an ordinary meaning that was already obvious and beyond dispute: the question below was only whether that meaning governed or whether it was displaced by some narrower meaning compelled by the specification or prosecution history. Any questions about the use of dictionaries that might arise in other cases are utterly beside the point in this case.[20]

In any event, there is no meaningful general issue about the use of dictionaries to help illuminate a claim term's ordinary meaning (if it has one). As with statutory construction, dictionaries *can* be useful–perhaps technical dictionaries are especially useful in construing general terms well known to technicians but less familiar to lay judges. That is so even though dictionaries might, of course, not supply a unique answer and must be applied in the relevant technological context and not through "cherry-picked" or "random" selection.

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[20] Infineon, even while repudiating "extrinsic" evidence, asserts, with carefully ambiguous language, that Rambus's expert did not contest that the "specification uses the term 'bus' as Infineon construes that term." Pet. 28. All that this does or could mean is that Rambus's expert said that *certain* parts of the specification described a *particular inventive bus* (by using modifying phrases) as involving multiplexing.

Pet. 28, 2. Not one word in any decision of this Court cited by Infineon, or any other decision to our knowledge, is to the contrary. The district court here recognized the appropriateness of using dictionaries to illuminate ordinary meaning. Every active judge of the Federal Circuit has written opinions—and joined still others–confirming the usefulness of dictionaries in this task.[21] And the Federal Circuit has been fully sensitive to the nuances of making appropriate use of dictionaries. *See, e.g., Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 326 F.3d 1215, 1221-22 (Fed. Cir. 2003); *Texas Digital*, 308 F.3d at 1203-04.

B. Ordinary Meaning. On the separate question of ordinary meaning's presumptively governing status, Infineon has tried to manufacture an issue by changing the subject, presenting the issue as a dispute over the primacy of "intrinsic

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[21] *See, e.g., Abbott Laboratories v. Syntron Bioresearch, Inc.* 2003 WL 21544291 (Fed. Cir.), at *5; *Omega Engineering, Inc, v. Raytek Corp.*, 2003 WL 21517751 (Fed. Cir.), at *6-*7; *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1346 (Fed. Cir. 2003); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003); *Middleton, Inc. v. Minnesota Mining & Manufacturing Co.*, 311 F.3d 1384, 1387 (Fed. Cir. 2002); *Inverness Medical Switzerland GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1369 (Fed. Cir. 2002); *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002), *cert. denied*, 123 S. Ct. 2230 (2003) (claim construction question); *Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.*, 308 F.3d 1167, 1177 (Fed. Cir. 2002); *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001); *Dow Chemical Co. v. Sumitomo Chemical Co., Ltd.*, 257 F.3d 1364, 1372-73 (Fed. Cir. 2001); *Tate Access Floors, Inc. v. Maxcess Technologies Inc.*, 222 F.3d 958, 965 (Fed. Cir. 2000); *Hill-Rom Co., Inc. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1340-41 (Fed. Cir. 2000); *Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324, 1335, 1338 (Fed. Cir. 2000); *EMI Group N. Amer., Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed. Cir. 1998); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996). *See also Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, 1459 (Fed. Cir. 1998) (*en banc*).

evidence." But the court of appeals here did not question that primacy, which is not in dispute. As Infineon itself recognizes, the first piece of "intrinsic evidence" is "the claim language." Pet. 21 ("the claim language, specification, and prosecution history"). Here, the claim language has an indisputably clear meaning to persons of skill in the art: a "bus" does not require multiplexing. Giving that language its unambiguous meaning to skilled artisans in the field *is* giving primacy to the primary piece of "intrinsic" evidence, which, therefore, is furnishing the required "public notice" of patent scope (*id.* at 26).

Indeed, Infineon appears to recognize that such an unambiguous meaning presumptively governs. Pet. 29. With that proposition not really in dispute, Infineon's petition is wholly dependent on a case-specific disagreement with the court of appeals' unanimous conclusion that "bus" had a clear ordinary meaning. That disagreement, not even developed in the petition, presents no general legal issue.

In any event, Infineon never directly contends that a claim's ordinary meaning is less than presumptively controlling. Nor could it so contend, without confusing the statutory role of the *claims* with the statutory role of the other parts of the specification. The claims define the invention (35 U.S.C. § 112, ¶ 2), whereas the lengthy specification preceding the claims serves different functions: it picks out and identifies "the best mode" of carrying out the invention and, more generally, provides a detailed enough teaching to enable a skilled artisan to make and use the invention (35 U.S.C. § 112, ¶ 1). It is particularly important not to confuse those roles where, as here, the specification describes many "independent and distinct" inventions (35 U.S.C. § 121)–so that individual aspects of what is described in combination in the specification can be and are claimed *separately*, without each one incorporating the others.

Contrary to the petition (Pet. 22), nothing whatever in this Court's decisions undermines the presumptive primacy of ordinary meaning in construing claims. The Court has long made clear that "it is the[] claims, not the specifications, that afford the measure of the grant to the patentee" (*Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143, 145-46 (1942)) and that "while the courts may construe the same in view of the specifications and the state of the art, they may not *add to or detract from* the claim."[22] This Court's decision in *Markman*, like *Warner-Jenkinson* afterwards (520 U.S. at 24, 29, 33, 37), notes the important distinction between the claims as defining the invention and the written description (517 U.S. at 373, 379), and it nowhere denies the primacy of ordinary meaning.[23] Nor is there any inconsistency between presumptive primacy of ordinary meaning and the principle that a claim construction must comport with the whole document (*Markman*, 517 U.S. at 389-90), just as there is no inconsistency among the *statutory*-construction principles that a word presumptively bears its ordinary meaning and must be construed in the context of the whole statute, which

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[22] *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U.S. 399, 410 (1905) (emphasis added); *see Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1908). Whether to narrow claim meaning to features in a specification is a two-way street, for breadth of claims, while expanding scope, can defeat validity, yet "[i]t is axiomatic that a claim must be interpreted the same way in determining infringement and invalidity" (5A D. Chisum, *Patents* § 18.03[2][h] (1998)). *See Howe Machine Co. v. National Needle Co.*, 134 U.S. 388, 394 (1890) (rejecting narrowing of claim meaning by patentee to avoid prior art).

[23] Indeed, although this Court in *Markman* decided only that claim construction was for judges rather than juries, the *en banc* decision it affirmed (without criticism on this point) explained that, to overcome ordinary meaning, "any special definition given to a word must be clearly defined in the specification. The written description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims." *Markman*, 52 F.3d at 980 (citation omitted).

can overcome ordinary meaning.[24] And the other precedents cited by Infineon (Pet. 22), even as it describes them in parentheticals, likewise say nothing to undermine the presumptively controlling character of a claim's ordinary meaning where it has one, with the descriptive portion of the specification being examined for consistency with such a meaning and helping to resolve ambiguity where it exists.[25]

Infineon is also wrong in arguing that the Federal Circuit is in internal conflict over these principles. "The rules are by now well known"; "'[i]t is the claims that measure the invention'"; there is "a heavy presumption that a claim term carries its ordinary and customary meaning"; and "claims are not perforce limited to the embodiments disclosed in the specification." *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1324-25, 1327, 1328 (Fed. Cir. 2003).[26]

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[24] *See, e.g., Johnson v. United States*, 529 U.S. 694, 706-07 & n.9, 715-17 (2000); *FDIC v. Meyer*, 510 U.S. 471, 476 (1994); *Smith v. United States*, 508 U.S. 223, 228-29 (1993).

[25] Infineon invokes the interest in consistency with PTO practice (Pet. 27), but it cites absolutely nothing to suggest that there is a PTO practice inconsistent with the presumptively controlling nature of ordinary meaning.

[26] These are old, repeatedly applied principles. *See, e.g., Prima Tek II, LLC v. PolyPap, SARL*, 318 F.3d 1143, 1148-49 (Fed. Cir. 2003); *Johnson Worldwide Assoc., Inc. v. Zebco Corp.*, 175 F.3d 985, 988-90 (Fed. Cir. 1999); *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1249-50 (Fed. Cir. 1998); *Kegel Co., Inc. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1427 (Fed. Cir. 1997); *York Prods., Inc. v. Central Tractor Farm & Farming Ctr.*, 99 F.3d 1568, 1572 (Fed. Cir. 1996) ("Without an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning."); *Markman*, 52 F.3d at 979-980 (*en banc*); *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994); *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 951 (Fed. Cir. 1993); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992); *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1579 (Fed. Cir. 1988); *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753,

What is required to overcome the presumption of ordinary meaning is inevitably context-specific: "Whether an invention is fairly claimed more broadly than the 'preferred embodiment' in the specification is a question specific to the content of the specification, the context in which the embodiment is described, the prosecution history, and if appropriate the prior art."[27] That context-specific analysis is precisely what the court of appeals performed. It correctly concluded that the particular inventive multiplexing bus was required only in claims that used modifiers to the general term "bus" to identify a particular version of a bus, but not where the term "bus" stood unmodified in claims to the *other* inventions described in Rambus's multiple-invention application, as confirmed by the original application and the PTO's insistence on dividing it into separate applications claiming the "distinct and independent" inventions.[28]

The Federal Circuit decisions cited by Infineon (Pet. 22-24) positively confirm this approach. Infineon's main authority, *Multiform Desiccants*, 133 F.3d at 1477-78, expressly states

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759 (Fed. Cir. 1984); *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 137 F.2d 3, 6 (7th Cir.1943), *aff'd*, 322 U.S. 471 (1944).

[27] *Teleflex*, 299 F.3d at 1327; *see Sunrace Roots Enterprise Co. v. SRAM Corp.*, 2003 WL 21665253, at *8 (Fed. Cir.); 5A D. Chisum, *Patents* § 18.03[2][b][ii] (1998); *VLT Corp. v. Lambda Elecs., Inc.*, 238 F. Supp. 2d 347, 350-51 (D. Mass. 2003) (so recognizing, cited at Pet. 25); *Borg Warner, Inc. v. New Venture Gear, Inc.*, 237 F. Supp. 2d 919, 928 (N.D. Ill. 2002) (same).

[28] In *SciMed Life Sys., Inc. v. Advanced Caridovascular Sys., Inc.*, 242 F.3d 1337 (Fed. Cir. 2001)–from which Infineon cites Judge Dyk's concurrence (Pet. 25)–the construction, as the Federal Circuit has made clear, rested on facts absent here: the specification made a "broad and unequivocal" assertion that "all embodiments" included a particular feature and distinguished prior art on that basis. *E.g.*, *Honeywell Inc. v. Victor Co.*, 298 F.3d 1317, 1325 (Fed. Cir. 2002) (panel including Judge Dyk); *Sunrace*, *supra*, at *7-*8. *See also Inverness*, *supra* (per Dyk, J.) (primacy of ordinary meaning).)

that any "special meaning" imparted by the inventor to a term in the specification "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention" and that "'[a] technical term used in a patent document is interpreted as having the meaning that it would be given by persons experienced in the field of the invention, unless it is apparent from the patent and the prosecution history that the inventor used the term with a different meaning.'"[29] The decision in *Vitronics*, *supra*–whose author later wrote the *Amgen* decision quoted at page 26, *supra*—also recognizes that "words in a claim are generally given their ordinary and customary meaning," to be overcome only if a "special definition of the term is clearly stated in the patent specification or file history." 90 F.3d at 1582; *see also id.* at 1584 n.6 (approving use of dictionaries). Infineon's three other authorities are fully in accord with this principle.[30]

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[29] *Multiform Desiccants* involved the claim term "degradable," which, unlike "bus" in this case, the court treated as having two possible relevant ordinary meanings (dissolvable or breakable) on the point in dispute. The court held that the patent required the former (the more natural one), based partly on how the inventor distinguished prior art. 133 F.3d at 1477-78. *Multiform Desiccants* has been cited for the principle that "[a] term of technical art, unless defined otherwise, by the patentee, has the meaning by which it would be understood by persons experienced in the field of the invention" (*Talbert Fuel Systems Patents Co. v. Unocal Corp.*, 275 F.3d 1371, 1375 (Fed. Cir.), *vacated on other grounds*, 123 S. Ct. 70 (2002); *see Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299 (Fed. Cir. 1999)).

[30] Infineon cites *Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 705-06 (Fed. Cir. 1997), only for the primacy of "intrinsic evidence," a non-issue here. *Renishaw*, 158 F.3d at 1249-50, recognizes the presumptive primacy of ordinary meaning, subject to rejection if it "flies in the face of the patent disclosure." *Toro*, 199 F.3d at 1299, citing *Multiform Dessicants*, recognizes "the general rule that words in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was

There is thus no need to clarify any claim-construction principles relevant to this case. It is a commonplace that claim-construction principles, like principles of statutory construction, apply differently to different records in different cases. The specification may be decisive where, for example, the claim term lacks an ordinary meaning resolving the point in dispute, or where a claim term has an ordinary meaning that was redefined or otherwise disclaimed, expressly or by clear implication, by the patentee. None of that was so here; to the contrary, the claim has an ordinary meaning, there is no disclaimer or redefinition, and the prosecution history, which shows "the framework of the invention as viewed by the inventor" and "the issues of patentability as viewed by the patent examiner" (*Multiform*, 133 F.3d at 1477), precludes Infineon's claim-narrowing treatment of all the independent inventions as dependent on one of the inventions (a particular configuration of bus). The Federal Circuit's reliance on ordinary meaning in this case, which was consistent with the specification and confirmed by the prosecution history, warrants no further review.[31]

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used with a special meaning." (*Toro* on one issue rejected a narrowing construction and on another found the terms "cover" and "including" too open-ended, considered by themselves, to resolve the point in dispute.)

[31] All four of the law-review articles cited by Infineon (Pet. 25 n.5) reiterate the soundness of the principle presumptively giving a claim its ordinary meaning. Hill & Cote, *Ending the Federal Circuit Crapshoot: Emphasizing Plain Meaning in Patent Claim Interpretation*, 42 IDEA 1, 2 (2002); Gallagher, *The Federal Circuit and Claim Construction: Resolving the Conflict Between the Claims and the Written Description*, 4 N.C. J. L. & Tech. 121, 121, 129, 142 (2002); Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time Is Ripe for a Consistent Claim Construction Methodology*, 8 J. Intell. Prop. Law 175, 218-21 (2001); *see also* Hatterbach, *Chickens, Eggs, and Other Impediments to Escalating Reliance on Dictionaries in Patent Claim Construction*, 85 J. Pat. & Trademark Off. Soc. 181, 183 (2003). The Hatterbach article focuses on the *timing* of considering dictionary definitions, which, if it presents a significant issue at all, is a non-issue in this case.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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